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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/574,173	KOBAYASHI ET AL.	
	Examiner	Art Unit	
	Tamra L. Dicus	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 September 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The 112 rejections over said relative terms and claim 18 are withdrawn from the prior Office Action. All other prior art rejections are modified to address the new limitations recited below.

Claim Objections

Claim 6 is objected to because of the following informalities: "a first sub-region" and "second sub-region" are not in the original specification as filed. If the sub-region is a region, it is suggested to reference language consistent with the instant specification. Appropriate correction is required.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first sub-portion, second portion and sub-portions must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-28: "low-gloss" and "low-luster" have been omitted from the claim and thus has broadened ~~the claims~~ "first region" and "ink layer" respectively, for which there is no support as originally filed for said broad "first region" and "ink layer" terms as those would encompass all regions including those without low gloss and all ink layers including high luster ink layers. Thus, the broad recitation of "first region" and "ink layer" terms are considered new matter.

Further to claim 6: "a first sub-region" and "second sub-region" are not in the original specification as filed and is also considered new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1- 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 refers to a second region; it is not clear what it is or where it is. Further, it is not clear what steps are involved or how the pattern ink layer serves to generate a difference in gloss between first and second regions. Claims 1 and 6 recite a second region and second sub-region and lower or different gloss, which from the originally filed specification (see for instance pg. 19, lines 25-26, pg. 20, lines 1-15) is absent a clear disclosure on what or where this location is. There is discussed a portion above the low-luster pattern ink layer and a surface protective layer over said ink layer, but not an additional portion to yield a gloss comparison or differential as claimed. Thus, the new limitations are confusing as they do not clearly differentiate where the second or sub-regions are. Similar rationale applies to a second sub-region of claim 6 and the generation of gloss in claim 2. Additionally, claim 1 recites a first and second region, however two regions are mentioned prior, which is confusing and is not in sequential order.

Further to claims 1 and 6, it is not clear if the first and second portions/sub-portions are mere optical effects or if some material is present. Moreover, if the first region is located in a

portion above the pattern ink layer, then the ink layer is already in the vicinity of the portion. Such description is repetitive and does not further limit claim 1.

See also claims 7 and 21, for same rationale applied to relative term "close". Further to claim 7, it is not clear what is intended by "plus-side value of a maximum thickness". Further the hyphenated term "plus-side" is not clear, does this mean a side has an additional side(s)? Also the comparison is further unclear because particle size is normally in diameters and to compare it to a thickness is not in the same units and not understood how this relationship is definite.

Further claim 27 recites "the low-luster pattern ink layer" which lacks antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 12-16, 19, 23-26, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 6,326,074 to Takahashi.

Takahashi teaches per instant Claim 1. A decorative material comprising at least a substrate (penetrable porous paper 1, FIGS. 1E and 2 and associated text, of penetrable paper, 4:44-45 (claim 16)), a pattern ink layer (nonpenetrable layer 5, FIGS. 1E and 2 and associated text, of the same compositions comprising pigments, silica (extender), and resins as in [0076] as in instant specification, and printed in a pattern, thus functioning as pattern ink layer, see also 5:40-68 teaching extender pigments) partially formed on the substrate, a color solid print (2, FIGS. 1E and 2 and associated text, penetration-preventing) and a surface protective layer (6, FIGS. 1E and 2 and

associated text) which is present on and in direct contact with the pattern ink layer so as to cover a whole surface including both a region where the pattern ink layer is formed (see regions where 5 is present) and a region where no pattern ink layer is formed (see regions where 5 is not present), wherein the surface protective layer is formed by crosslinking and curing an ionizing radiation-curable resin composition with UV or electron beam (6:18-30, methacrylate monomer or vinyl acetate or epoxy resins (claims 2, 4, 24), and provided therein with a first region which is located in a portion just above the low-luster pattern ink layer (see region above 5, FIGS. 1E and 2 and associated text) and in the vicinity of the portion, and with a second region (any area surrounding the pattern layer 5 that isn't one of the aforementioned portions such as to the left or right of the pattern), inherently having a lower gloss than a second region because the same materials are employed, and the pattern ink layer serves to generate a gloss difference inherently due to the same materials, wherein the first region is visually recognized as a concave portion (see upper concave portions illustrated in topcoat 6, FIGS. 1E and 2, 4:61-63, Example 1) and the first region has a convex shape (see convex shape in FIGS. 1E and 2). Regarding claims 2 and 3, the nonpenetrable pattern ink layer contains a non-crosslinked urethane (while not explicitly recited as "non-crosslinked" see 5:50-53, because the urethane is not said to be crosslinked with a crosslinking agent, then it is not crosslinked, and the ionizing resin also includes methacrylate monomer and unsaturated polyester-6:48-50 and 6:39 (while referred to generally at 5:50-51, is explained further to include additional ingredients at 6:39-50, (claims 2-4). Takahashi explains methacrylate monomer may be used alone at 6:35 (claim 4). Color solid print (2, FIGS. 1E and 2, and associated text), Takahashi teaches has an additional function to prevent the penetration of the ink (4:40-46) and states it functions as a penetration prevention layer. (Claims 15 and 26). Takahashi teaches attachment of the sheet to various adherends such as walls (7:50-60) and laminated onto wood or

glass plates (4:20-36, claim 28). While Takahashi does not explicitly recite first and second portions/sub-portions and gloss differentials and comparisons, see Examples 1-13 that clearly teach a glossiness (gloss) difference between gloss and non-gloss portions and difference in convex and concave levels (claim 25). Claims 1-4, 12-16, 19, 23-26, and 28 are met.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2 –4, 23-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi in view of Tsukada et al.

Takahashi essentially teaches the claimed invention (see materials above for claims 2, 23-26, and 28).

Takahashi does not expressly refer to a "non-crosslinked" urethane instant claim 2, while the urethane is not said to be crosslinked as set forth above, namely the ink layer containing a non-crosslinked urethane resin and methacrylate for the ionizing radiation-curable resin, or instant claim 3 unsaturated polyester or claim 4.

Tsukada teaches a similar decorative material comprising an ink comprising either an ionizing radiation-curable resin or it's mixture with an ionizing uncurable resin vehicle (binder) employing urethane, polyesters or an acrylic acid modified polyester (similar structure to unsaturated

polyester, thus similar properties expected) and a (meth)acrylate monomer (3:10-15, 3:65-68, 4:1-50, 7:60-68, 8:45-68, 9:9-30).

It would have been obvious to one having ordinary skill in the art to have modified the decorative material of Takahashi to use or substitute an uncurable resin and methacrylate monomer because Tsukada teaches they are conventional resins used in inks and similar layers in a decorative material sheet (3:10-15, 3:65-68, 4:1-50, 7:60-68, 8:45-68, 9:9-30). To instant claim 4, choosing solely methacrylate monomer is an obvious choice resin since Tsukada teaches a variety of resins in a list, picking only one is obvious because the same results are expected. Moreover, Takahashi explains said monomer may be used alone at 6:35.

Claim 5-6 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi.

Takahashi essentially teaches the claimed invention.

Takahashi does not teach instant claims 5-6 and 20-21.

To instant claims 5-6, and 20-21 the thickness is not recited, however, it is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980).

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi solely or further in view of Tsukada et al.

Takahashi or the combination is relied upon above.

Takahashi or the combination does not teach the thickness recited, however, it is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980). Thickness effects the optical effect.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi solely or further in view of Tsukada et al. and further in view of Ogawa.

The references are relied upon above.

Said references do not teach the particles as per instant claim 21.

Ogawa teaches fine particles, particularly, baked kaolin which is a widely known filler and used as an equivalent to calcium carbonate and mixed with silica applied to a variety of films and coating resin compositions (9:30-68,10:1-55).

It would have been obvious to one having ordinary skill in the art to have modified the decorative material of Takahashi or the combination to include the ingredients as claimed because Ogawa teaches baked kaolin is a widely known filler used as equivalents to calcium carbonate and mixed with silica (10:1-15) applied to a variety of films (9:30-68). Further, it is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980).

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi solely or further in view of Tsukada et al. and further in view of 4,855,184 to Klun et al.

The references are relied upon above.

Said references do not teach the particles as per instant claim 22.

Klun teaches a radiation-curable coating protective layer of ethylene oxide and propylene oxide with N-methylolacrylaimdes for wood or plastic coatings; see further 1:1-10, 18: 25-30, 20:19-30.

Ogawa teaches fine particles, particularly, baked kaolin which is a widely known filler and used as an equivalent to calcium carbonate and mixed with silica applied to a variety of films and coating resin compositions (9:30-68,10:1-55).

It would have been obvious to one having ordinary skill in the art to have modified the decorative material of Takahashi or the combination to include the ingredients as claimed because Klun teaches it is a composition for radiation –curable protective coatings for plastic and wood substrates and Ogawa teaches baked kaolin is a widely known filler used as equivalents to calcium carbonate and mixed with silica (10:1-15) applied to a variety of films (9:30-68).

Claim 7-11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi solely or in view of US 4,855,184 to Klun et al. and in view of USPN 5,266,397 to Ogawa et al.

Takahashi essentially teaches the claimed invention above.

Takahashi discloses the ionizing radiation curable resin composition for the surface protecting layer. Takahashi does not expressly teach the composition recited per instant claim 11, but does teach trimethylolpropane ethylene oxide tri(meth)acrylate see 6:56-57. Takahashi teaches pigments and fine powders of calcium carbonate, and silica may be further additives within the

ionizing radiation curing resin (7:10-20), which the surface layer is comprised of. However, Takahashi does not teach baked kaolin per instant claim 11.

Klun teaches a radiation-curable coating protective layer of ethylene oxide and propylene oxide with N-methylolacrylaimdes for wood or plastic coatings; see further 1:1-10, 18: 25-30, 20:19-30.

Ogawa teaches fine particles, particularly, baked kaolin which is a widely known filler and used as an equivalent to calcium carbonate and mixed with silica applied to a variety of films and coating resin compositions (9:30-68,10:1-55).

It would have been obvious to one having ordinary skill in the art to have modified the decorative material of Takahashi to include the ingredients as claimed because Klun teaches it is a composition for radiation –curable protective coatings for plastic and wood substrates and Ogawa teaches baked kaolin is a widely known filler used as equivalents to calcium carbonate and mixed with silica (10:1-15) applied to a variety of films (9:30-68).

Takahashi does not expressly teach all the values recited per instant claims 7-10. It is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980). Further to the fine particles, see rational above using fine particles.

Claims 1, 5-6, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,558,799 to Takeuchi et al. in view of Takahashi.

Takeuchi teaches a decorative material in this order : 1, substrate (the Figure and associated text), 2A a penetrating preventing or color layer, 2B contains a pattern print, 2C is a color/penetration preventing layer, having a surface layer 3 on top. All of the layers except the substrate is from the same ionizing curable resin.

Takeuchi does not teach a concave portion and ink layer in that order laminated over the order per the instant claims.

Takahashi teaches a decorative material comprising at least a substrate (penetrable porous paper 1, FIGS. 1E and 2 and associated text, of penetrable paper, 4:44-45), a pattern ink layer (nonpenetrable layer 5, FIGS. 1E and 2 and associated text, of the same compositions comprising pigments, silica (extender), and resins as in [0076] as in instant specification, and printed in a pattern, thus functioning as pattern ink layer, see also 5:40-68 teaching extender pigments) partially formed on the substrate, and a surface protective layer (6, FIGS. 1E and 2 and associated text) which is present on and in direct contact with the pattern ink layer so as to cover a whole surface including both a region where the pattern ink layer is formed (see regions where 5 is present) and a region where no pattern ink layer is formed (see regions where 5 is not present), wherein the surface protective layer is formed by crosslinking and curing an ionizing radiation-curable resin composition (methacrylate monomer or vinyl acetate or epoxy resins), and provided therein with a first region which is located in a portion just above the low-luster pattern ink layer (see region above 5, FIGS. 1E and 2 and associated text) and in the vicinity of the portion, and with a second region (any area surrounding the pattern layer 5 that isn't one of the aforementioned portions such as to the left or right of the pattern), inherently having a lower gloss than a second region because the same materials are employed, and the pattern ink layer serves to generate a gloss difference inherently due to the same materials, wherein the first region is visually recognized as a concave portion (see upper

concave portions illustrated in topcoat 6, FIGS. 1E and 2, 4:61-63, Example 1) and the first region has a convex shape (see convex shape in FIGS. 1E and 2). While Takahashi does not explicitly recite first and second portions/sub-portions and gloss differentials and comparisons, see Examples 1-13 that clearly teach a glossiness (gloss) difference between gloss and non-gloss portions and difference in convex and concave levels.

It would have been obvious to one having ordinary skill in the art to have modified the decorative material of Takeuchi to include overtop a laminated topcoat surface protective layer and low-gloss pattern as claimed because Takahashi teaches such a covering provides an embossed three-dimensional effect (4:1-15 and as cited above).

The woodgrain pattern (9:50-60 inherently having vessels because it is a wood grained pattern) of claim 18 is provided by Takeuchi and embraced (4:45-60, grains, tile patterns) by Takahashi, and would have been expected to produce a pattern as set forth in claim 18.

To instant claims 5-6, the thickness is not recited, however, the same silk screen printing method is used as in the instant specification (9:35-40, Takeuchi), and materials, and thus the thickness would be expected. It is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980).

Claims 2-4 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,558,799 to Takeuchi et al. in view of Takahashi and further in view of Tsukada et al.

Takeuchi teaches a decorative material in this order : 1, substrate (the Figure and associated text), 2A a penetrating preventing or color layer, 2B contains a pattern print, 2C is a

color/penetration preventing layer, having a surface layer 3 on top. All of the layers except the substrate is from the same ionizing curable resin.

Takeuchi does not teach a concave portion and ink in that order laminated over the order as disclosed by Takeuchi and the instant claims. Takeuchi doesn't explicitly reference a "non-crosslinked" urethane as per instant claim 2, namely the ink layer containing a non-crosslinked urethane resin and methacrylate for the ionizing radiation-curable resin or the ingredients per claims 3-4.

Takahashi teaches a decorative material comprising at least a substrate (penetrable porous paper 1, FIGS. 1E and 2 and associated text, of penetrable paper, 4:44-45), a pattern ink layer (nonpenetrable layer 5, FIGS. 1E and 2 and associated text, of the same compositions comprising pigments, silica (extender), and resins as in [0076] as in instant specification, and printed in a pattern, thus functioning as pattern ink layer, see also 5:40-68 teaching extender pigments) partially formed on the substrate, and a surface protective layer (6, FIGS. 1E and 2 and associated text) which is present on and in direct contact with the pattern ink layer so as to cover a whole surface including both a region where the pattern ink layer is formed (see regions where 5 is present) and a region where no pattern ink layer is formed (see regions where 5 is not present), wherein the surface protective layer is formed by crosslinking and curing an ionizing radiation-curable resin composition (methacrylate monomer or vinyl acetate or epoxy resins), and provided therein with a first region which is located in a portion just above the low-luster pattern ink layer (see region above 5, FIGS. 1E and 2 and associated text) and in the vicinity of the portion, and with a second region (any area surrounding the pattern layer 5 that isn't one of the aforementioned portions such as to the left or right of the pattern), inherently having a lower gloss than a second region because the same materials are employed, and the pattern ink layer serves to generate a gloss difference inherently due to the

same materials, wherein the first region is visually recognized as a concave portion (see upper concave portions illustrated in topcoat 6, FIGS. 1E and 2, 4:61-63, Example 1) and the first region has a convex shape (see convex shape in FIGS. 1E and 2). Takahashi teaches attachment of the sheet to various adherends such as walls (7:50-60) and laminated onto wood or glass plates (4:20-36, claim 28). While Takahashi does not explicitly recite first and second portions/sub-portions and gloss differentials and comparisons, see Examples 1-13 that clearly teach a glossiness (gloss) difference between gloss and non-gloss portions and difference in convex and concave levels.

It would have been obvious to one having ordinary skill in the art to have modified the decorative material of Takeuchi to include overtop a laminated topcoat surface protective layer and low-gloss pattern as claimed because Takahashi teaches such a covering provides an embossed three-dimensional effect (4:1-15 and as cited above).

The combination does explicitly reference a "non-crosslinked" urethane as per instant claim 2, namely the ink layer containing a non-crosslinked urethane resin and methacrylate for the ionizing radiation-curable resin or the ingredients per claims 3-4.

Tsukada teaches a similar decorative material comprising an ink comprising either an ionizing radiation-curable resin or it's mixture with an ionizing uncurable resin vehicle (binder) employing urethane, polyesters or an acrylic acid modified polyester (similar structure to unsaturated polyester, thus similar properties expected) and a (meth)acrylate monomer (3:10-15, 3:65-68, 4:1-50, 7:60-68, 8:45-68, 9:9-30).

It would have been obvious to one having ordinary skill in the art to have modified the decorative material of the combinatoin to use an uncurable resin and methacrylate monomer because Tsukada teaches they are conventional resins used in inks and similar layers in a decorative material sheet (3:10-15, 3:65-68, 4:1-50, 7:60-68, 8:45-68, 9:9-30).

Response to Arguments

Applicant's arguments filed 09-24-07 have been fully considered but they are not persuasive.

Applicant argues the 112 2nd paragraph rejection over claim 7, arguing [0101] explains a definition of what is meant by close to a plus-side value, however, the Examiner does not agree for the reasons set forth above. Further within this paragraph is not a definition of what "plus-side value thickness" is.

Applicant argues none of the claims as recited are taught by the references set forth, however, this is not convincing because the primary references teach the claimed invention. See again Takahashi explicitly teaching all of the layers and their gloss and convex appearances. Further because the exact same material is used, it is expected that the effects are inherently present despite Applicant's allegation that the references do not teach this. Applicant further argues properties such as excellent durability, satisfactory feel, and less complicated processing and costs, and light scattering; however, these are properties and effects that naturally flow from the same materials and ordered structures.

The Applicant argues the direct contact between the surface protective layer and pattern ink layer, again, as set forth above, Takahashi's surface protective layer 6 is in direct contact with pattern ink layer 5 see FIG 1E. The composition of layer 5 includes a binder, solvent, and pigment, which is the formula for ink and Takashshi also teaches this layer is printed, while not expressly referring to it as "ink".

Applicant also points to Fig. 1 of the instant specification, further arguing curing in a suspended state, however, this is not in the claim and is further a process limitation, but is nonetheless provided in the prior art because the final product is cured.

Applicant continues to argue coating amounts of pattern ink layer, pointing to Applicant's specification and pages therein, but these limitations are not in the claim and limitations from the specification are not read into the claims.

Applicant argues a minor formality regarding the rejection statement of the prior Office Action on page 3, where claim 1 was not included in the rejection statement, but in the body of the rejection. This typo has been corrected as set forth above.

Further discussion to Takahashi has been discussed above, namely the nonpentrable layer is a pattern ink layer as the same composition and printing is provided for by Takahashi, in response to Applicant's arguments to the separation of the pattern layer from the top coat layer.

Applicant argues Tsukada doesn't teach the direct contact limitations, however, as set forth above, Takahashi teaches this limitation. Takeuchi was relied upon to teach the successive lamination, further adding the layers of Takahashi are obvious to coat over it to add a 3-D effect. Applicant further argues Takeuchi's layer 2C is not the patterned layer, however, the Examiner does not rely on 2C as the patterned layer, but the color penetration prevention layer as set forth above. All other references are used for the reasons set forth above. Thus, Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Note that regarding the prior rejection of Claim 27 over Takeuchi, Takahashi and further in view of Tsukada, claim 2 was recited in the body of the rejection, but the Examiner erroneously did not include claim 2 in the rejection statement (see page 12, first complete paragraph of the prior Office Action dated 06/22/07). However, it is a minor oversight which has been corrected above as claim 27 depends from claim 2. With respect to Takeuchi in view of Takahashi, claim 18 was recited in the body of the rejection, but the Examiner erroneously did not include claim 18 in the rejection statement (see pg. 10, second complete paragraph). Furthermore because applicant amended claims

1 and 2 by adding "in direct contact" regarding the pattern ink and surface protective layer, this has changed the structure and has necessitated a new grounds of rejection. Thus because there is no new art that has been presented, and the basic thrust of the rejection remains the same, it is therefore not considered a new ground of rejection. See MPEP 1207.03: There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. (underlining added by Examiner for emphasis) Id. At 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tamra L. Dicus
Examiner
Art Unit 1794

November 26, 2007

Callie Shosho
Callie Shosho
Supervisory Patent Examiner